IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	William K. Bodin, et al.	Examiner: Manglesh M. Patel
Serial No.:	10/734,764	Group Art Unit: 2178
Filed:	Dec 11, 2003	Docket No.: AUS920030835US1
Assignee:	International Business Machines Corporation	
Title:	CREATING A PRESENTATION DOCUMENT	

APPELLANT'S BRIEF ON APPEAL

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This brief is presented in support of the Notice of Appeal filed on February 9, 2011, from the final rejection of pending claims 1-24 of the above-identified patent application. The Office Action from which Appellant appeals was mailed 12/09/2010.

Please charge any required additional fees or credit overpayment to Deposit Account No. 09-0447.

Appellant respectfully requests reversal of the Examiner's rejection of pending claims 1-24.

APPELLANT'S BRIEF ON APPEAL

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, International Business Machines Corporation.

2. RELATED APPEALS AND INTERFERENCES

A Decision on Appeal by the Board of Patent Appeals and Interferences for a previous Appeal of the present application having an Appeal Docket 2009-004171 and a notification date of February 1, 2010 was decided on January 28, 2010. A copy of the Decision on Appeal is attached to this brief in the "Related Proceedings Appendix."

3. STATUS OF THE CLAIMS

No claims have been cancelled or added. No claims have been allowed. Claims 1-24 have been at least twice rejected. Claims 1-24 are pending, and are the subject of the present appeal.

4. STATUS OF THE AMENDMENTS

Claims 1-24 were rejected in a Final Office Action dated 12/09/2010 (hereinafter "the Final Office Action").

No further amendments were made after the Final Office Action of 12/09/2010.

A Notice of Appeal was filed on February 9, 2011.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

This summary is presented in compliance with the requirements of Title 37 C.F.R. § 41.37(c)(1)(v), mandating a "concise explanation of the subject matter defined in each of the independent claims involved in the appeal ..." Nothing contained in this summary is intended to change the specific language of the claims described, nor is the language of this summary to be construed so as to limit the scope of the claims in any way.

The three independent claims involved in this appeal are claims 1, 9, and 17.

Claim 1 recites a method for creating a presentation document (described for example at page 11, lines 19-20, and Figure 3 at element 314). The method of claim 1 includes creating, in dependence upon an original document, a structured document comprising one or more structural elements (described for example at page 11, lines 20-28 and Figure 3 at elements 304, 302, 306, and 402). The method of claim 1 also includes creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document. The presentation grammar comprises a data structure that includes grammar elements. The grammar elements include a presentation action identifier (described for example at page 8, line 18 to page 9, line 4 and Figure 5, element 518). The grammar elements also include a key phrase for invoking a presentation action (described for example at page 9, lines 15-29 and at Figure 5, element 516). The grammar elements further include a structural element identifier for at least one structural element of the structured document (described for example at page 11, line 28, through page 15, line 15 and Figure 3 at elements 310, 312, 306, 316, 318, and 402). Additionally, the grammar elements include a parameter type for parsing received speech and formulating a presentation control instruction (described for example at page 13, lines 1-13). The parameter type identifies a type of a parameter, wherein the parameter is received from a user after the key phrase and controls presentation control instruction corresponding to the presentation action that is invoked by the user speaking the key phrase. (described for example at page 13, lines 1-13).

Claim 9 recites a system for creating a presentation document (described for example at page 11, lines 19-20, and Figure 3 at element 314). The system of claim 9 includes means for

creating, in dependence upon an original document, a structured document comprising one or more structural elements (described for example at page 11, lines 20-28 and Figure 3 at elements 304, 302, 306, and 402). The system of claim 9 also includes means for creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document comprises a data structure that includes grammar elements. The grammar elements include a presentation action identifier (described for example at page 8, line 18 to page 9, line 4 and Figure 5, element 518). The grammar elements also include a key phrase for invoking a presentation action (described for example at page 9, line 15-29 and at Figure 5, element 516). The grammar elements further include a structural element identifier for at least one structural element of the structured document (described for example at page 11, line 28, through page 15, line 15 and Figure 3 at elements 310, 312, 306, 316, 318, and 402). Additionally, the grammar elements include a parameter type for parsing received speech and formulating a presentation control instruction (described for example at page 13, lines 1-13). The parameter type identifies a type of a parameter, wherein the parameter is received from a user after the key phrase and controls presentation control instruction corresponding to the presentation action that is invoked by the user speaking the key phrase. (described for example at page 13, lines 1-13). The means for carrying out the acts included in the system of claim 9 include a computer system (described for example at page 7, lines 5-15).

Claim 17 recites a computer program product for creating a presentation document (described for example at page 11, lines 19-20, and Figure 3 at element 314). The computer program product of claim 17 includes a recording medium (described for example at page 7, lines 19-21). The computer program product of claim 17 also includes means, recorded on the recording medium, for creating, in dependence upon an original document, a structured document comprising one or more structural elements (described for example at page 11, lines 20-28 and Figure 3 at elements 304, 302, 306, and 402). The computer program product of claim 17 also includes means, recorded on the recording medium, for creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document

comprises a data structure that includes grammar elements. The grammar elements include a presentation action identifier (described for example at page 8, line 18 to page 9, line 4 and Figure 5, element 518). The grammar elements also include a key phrase for invoking a presentation action (described for example at page 9, line 15-29 and at Figure 5, element 516). The grammar elements further include a structural element identifier for at least one structural element of the structured document (described for example at page 11, line 28, through page 15, line 15 and Figure 3 at elements 310, 312, 306, 316, 318, and 402). Additionally, the grammar elements include a parameter type for parsing received speech and formulating a presentation control instruction (described for example at page 13, lines 1-13). The parameter type identifies a type of a parameter, wherein the parameter is received from a user after the key phrase and controls presentation control instruction corresponding to the presentation action that is invoked by the user speaking the key phrase. (described for example at page 13, lines 1-13). The means for carrying out the acts included in the computer program product of claim 17 include computer program instructions embedded in the recording medium of the computer program product (described for example at page 7, lines 17-28).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-7, 9-15, and 17-23 stand rejected under 35 U.S.C. 102(b) as being anticipated by Raman (U.S. Patent 5,748,186), issued May 5, 1998 (hereinafter "Raman")

Claims 8, 16 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Raman as applied to claim 1 above, and further in view of Josephson, (U.S. Patent Publication 2003/0023435 A1), published January 30, 2003 (hereinafter "Josephson").

7. ARGUMENT

A) The Applicable Law under 35 U.S.C. §102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P § 2131.* To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

B) Discussion of the Rejection of Claims 1-7, 9-15, and 17-23 under 35 U.S.C. 102(b) as being anticipated by Raman.

Claims 1-7, 9-15, and 17-23 stand rejected under 35 U.S.C. 102(b) as being anticipated by Raman. Appellant respectfully submits that the Examiner has clearly erred, because claims 1-7, 9-15 and 17-23 recite elements not found in Raman. For example, claim 1 recites a presentation grammar comprising a data structure that include grammar elements, where the grammar elements include "a parameter type to be used in parsing received speech, wherein the parameter type identifies a type of a parameter, wherein the parameter is received from a user

after the key phrase and controls a presentation control instruction corresponding to the presentation action that is invoked by the user speaking the key phrase." Raman fails to disclose multiple elements recited in the claim. With respect to the recited language, the Office Action makes a generalized statement:

> In addition, the presentation can momentarily pause on the links so that the user can select the link using a voice input unit" further stating "... interact with the forms using speech", Raman therefore discloses a parameter type to be used in parsing the received speech, for example the received speech is parsed and then the parameter type identifies a link for selection or a parameter type identifies a form component for selection and display. (Final Office Action at page 4)

Several points of clear error exist in the Final Office Action's analysis. The Final Office Action only specifically identifies one component, a parameter type, as being present in Raman. Neither the portion of the Final Office Action provided above, nor any other portion of the Final Office Action identifies any element in Raman that corresponds with or discloses a "presentation action identifier", a "key phrase" a "presentation action" or a "presentation control instruction", each of which are specifically recited in claim 1.

Further, Appellant respectfully submits that the analysis provided in the Final Office Action is clearly erroneous because Raman fails to disclose a parameter type. As recited in claim 1, a parameter type "identifies a type of a parameter", where the parameter is "received from a user after the key phrase" and "controls a presentation control instruction." Appellant notes that a parameter type is for a parameter that is received form user after a key phrase. Raman fails to disclose parameters received after a key phrase. While Raman discloses at a very high level that voice input may be used to select a link or provide input to a form in response to a prompt, Raman fails to disclose any details as to the form of the input or how such input may be parsed. In contrast, Appellant's claims recite that parameters are received "after the key phrase." There is no disclosure that the speech input of Raman is parsed in any way such that the speech input includes both a key phrase and a parameter received after the key phrase. In particular, Raman fails to disclose any parsing whatsoever of speech input. The mere fact that

speech input may be used to select a link or provide input to a form in response to a prompt does not explicitly or inherently disclose or require grammar elements comprising a key phrase and a parameter provided after the key phrase that controls a presentation control instruction that corresponds to a presentation action.

Further, Raman fails to disclose a parameter type that identifies a type of parameter as recited in claim 1. As discussed in the specification at page 13, lines 1-13 and in the examples provided in Table 1 at page 14 and the discussion at page 15, a parameter type indicates whether a parameter is required (e.g., a non-null value) and if required, a type for the parameter (e.g., integer, string etc.). Again, Raman merely discloses at a high level that speech or voice input may be used to specify a link or provide input to a form in response to a prompt. There simply is no disclosure in Raman that such input has parameters, nor is there any disclosure in Raman of any type associated with information provided as voice input. Therefore Raman fails to disclose a "parameter type that identifies a type of parameter" as recited in claim 1.

For all of the above reasons, Raman fails to disclose multiple elements of Appellant's claim 1. As a result, Raman fails to anticipate claim 1. Therefore the Final Office Action is clearly erroneous in asserting that Raman does anticipate claim 1. Appellant respectfully requests reversal of the rejection of claim 1.

The Final Office Action rejected claim 9, stating that "claims 9-15 incorporate substantially similar subject matter as claimed in claims 1-8, respectively, and are rejected along the same rationale." Claim 9, like claim 1, recites a presentation grammar that includes grammar elements that include "a parameter type to be used in parsing received speech, wherein the parameter type identifies a type of a parameter, wherein the parameter is received from a user after the key phrase and controls a presentation control instruction corresponding to the presentation action that is invoked by the user speaking the key phrase." As discussed above, Raman fails to disclose a parameter type that "identifies a type of a parameter", where the

parameter is "received from a user after the key phrase" and "controls a presentation control instruction." Thus Raman fails to disclose multiple elements of claim 9 for the same reasons as discussed above regarding claim 1, and therefore fails to anticipate claim 9. Appellant respectfully requests reversal of the rejection of claim 9.

The Final Office Action rejected claim 17, stating that claims 17-23 "incorporate substantially similar subject matter as claimed in claims 1-8, respectively, and are rejected along the same rationale." Claim 17, like claim 1, recites a presentation grammar that includes grammar elements that include "a parameter type to be used in parsing received speech, wherein the parameter type identifies a type of a parameter, wherein the parameter is received from a user after the key phrase and controls a presentation control instruction corresponding to the presentation action that is invoked by the user speaking the key phrase." As discussed above, Raman fails to disclose a parameter type that "identifies a type of a parameter", where the parameter is "received from a user after the key phrase" and "controls a presentation control instruction." Thus Raman fails to disclose multiple elements of claim 17 for the same reasons as discussed above regarding claim 1, and therefore fails to anticipate claim 17. Appellant respectfully requests reversal of the rejection of claim 17.

Claims 2-7, 10-15, and 18-23 depend respectively from independent claims 1, 9, and 17. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Raman does not disclose each and every element of the independent claims, Raman does not disclose each and every element of the dependent claims of the present application. Therefore Raman does not anticipate claims 2-7, 10-15, and 18-23. Appellant respectfully requests reversal of the rejection of claims 2-7, 10-15 and 18-23.

B) The Applicable Law under 35 U.S.C. §103

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.,* 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

D) Discussion of the Rejection Under 35 U.S.C. § 103 of Claims 8, 16 and 24 as being unpatentable over Raman and further in view of Josephson.

Claims 8, 16 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Raman as applied to claim 1 and further in view of Josephson. Claims 8, 16 and 24 depend from

claims 1, 9 and 17 respectively and therefore include all limitations of their respective base claims. The Final Office Action relies on the previous § 102 rejection arguing that Raman discloses each and every limitation of claims 1, 9, and 17. As explained above, however, Raman in fact does not disclose each and every element of independent claims 1, 9, and 17. In particular, Raman does not disclose at least a presentation grammar comprising a data structure that include grammar elements, where the grammar elements include "a parameter type to be used in parsing received speech, wherein the parameter type identifies a type of a parameter, wherein the parameter is received from a user after the key phrase and controls a presentation control instruction corresponding to the presentation action that is invoked by the user speaking the key phrase." Josephson fails to cure the deficiency in Raman. Therefore the proposed combination of Raman and Josephson fails to disclose each and every element of independent claim dependent claims 8, 16, and 24. Therefore proposed combination of Raman and Josephson therefore cannot establish a *prima facie* case of obviousness. Therefore the Final Office Action clearly errs when it states that the claims are obvious in view of the combination of Raman and Josephson. Appellant respectfully requests reversal of the rejection of claims 8, 16 and 24.

8. CONCLUSION

It is respectfully submitted that the claimed invention is not unpatentable in view of the cited art. It is respectfully submitted that claims 1-24 should therefore be allowed. Reversal of the Examiner's rejections of claims 1-24 is respectfully requested.

Respectfully submitted,

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CLAIMS APPENDIX: THE CLAIMS ON APPEAL

1. (Previously Presented) A method for creating a presentation document, the method comprising:

creating, in dependence upon an original document, a structured document comprising one or more structural elements; and

creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document comprises a data structure that includes grammar elements each of which includes:

a presentation action identifier;

a key phrase for invoking a presentation action;

a structural element identifier for at least one structural element of the structured document; and

a parameter type to be used in parsing received speech, wherein the parameter type identifies a type of a parameter, wherein the parameter is received from a user after the key phrase and controls a presentation control instruction corresponding to the presentation action that is invoked by the user speaking the key phrase.

2. (Original) The method of claim 1 wherein creating a structured document further comprises inserting in the structured document structural element identifiers for the structural elements.

3. (Original) The method of claim 1 wherein creating a structured document further comprises converting existing structural element identifiers from the original document to structural element identifiers for the structural elements of the structured document.

4. (Original) The method of claim 1 wherein creating a presentation grammar for the structured document comprises:
identifying the content type of the original document;
selecting, in dependence upon the content type, a full presentation grammar from among a multiplicity of full presentation grammars; and
filtering the full presentation grammar into a presentation grammar for the structured document in dependence upon the structural elements of the structured document.

5. (Original) The method of claim 4 wherein identifying the content type comprises identifying the content type in dependence upon a filename extension.

6. (Original) The method of claim 4 wherein identifying the content type comprises identifying the content type in dependence upon document header elements.

7. (Original) The method of claim 4 wherein filtering the full presentation grammar comprises writing from the full presentation grammar to the presentation grammar for the structured document each grammar element having a structural element identifier of a structural element that occurs in the structured document.

8. (Original) The method of claim 4 wherein the full grammar comprises a multiplicity of grammar elements for the content type, wherein each grammar element includes:
an identifier of a structural element;
a key phrase for invoking a presentation action; and
a presentation action identifier representing a presentation action.

9. (Previously Presented) A system for creating a presentation document, the system comprising:
means for creating, in dependence upon an original document, a structured document comprising one or more structural elements; and

means for creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document comprises a data structure that includes grammar elements each of which includes:

a presentation action identifier;

a key phrase for invoking a presentation action;

a structural element identifier for at least one structural element of the structured document; and

a parameter type to be used in parsing received speech, wherein the parameter type identifies a type of a parameter, wherein the parameter is received from a user after the key phrase and controls a presentation control instruction corresponding to the presentation action that is invoked by the user speaking the key phrase.

10. (Original) The system of claim 9 wherein means for creating a structured document further comprises means for inserting in the structured document structural element identifiers for the structural elements.

11. (Original) The system of claim 9 wherein means for creating a structured document further comprises means for converting existing structural element identifiers from the original document to structural element identifiers for the structural elements of the structured document.

12. (Original) The system of claim 9 wherein means for creating a presentation grammar for the structured document comprises:

means for identifying the content type of the original document;

means for selecting, in dependence upon the content type, a full presentation grammar from among a multiplicity of full presentation grammars; and

means for filtering the full presentation grammar into a presentation grammar for the structured document in dependence upon the structural elements of the structured document.

13. (Original) The system of claim 12 wherein means for identifying the content type comprises means for identifying the content type in dependence upon a filename extension.

14. (Original) The system of claim 12 wherein means for identifying the content type comprises means for identifying the content type in dependence upon document header elements.

15. (Original) The system of claim 12 wherein means for filtering the full presentation grammar comprises means for writing from the full presentation grammar to the presentation grammar for the structured document each grammar element having a structural element identifier of a structural element that occurs in the structured document.

16. (Original) The system of claim 12 wherein the full grammar comprises a multiplicity of grammar elements for the content type, wherein each grammar element includes:
an identifier of a structural element;
a key phrase for invoking a presentation action; and
a presentation action identifier representing a presentation action.

17. (Previously Presented) A computer program product for creating a presentation document, the computer program product comprising:
a recording medium;
means, recorded on the recording medium, for creating, in dependence upon an original document, a structured document comprising one or more structural elements; and

means, recorded on the recording medium, for creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document comprises a data structure that includes grammar elements each of which includes:

a presentation action identifier;

a key phrase for invoking a presentation action;

a structural element identifier for at least one structural element of the structured document; and

a parameter type to be used in parsing received speech, wherein the parameter type identifies a type of a parameter, wherein the parameter is received from a user after the key phrase and controls a presentation control instruction corresponding to the presentation action that is invoked by the user speaking the key phrase.

18. (Original) The computer program product of claim 17 wherein means, recorded on the recording medium, for creating a structured document further comprises means, recorded on the recording medium, for inserting in the structured document structural element identifiers for the structural elements.

19. (Original) The computer program product of claim 17 wherein means, recorded on the recording medium, for creating a structured document further comprises means, recorded on the recording medium, for converting existing structural element identifiers from the original document to structural element identifiers for the structural elements of the structured document.

20. (Original) The computer program product of claim 17 wherein means, recorded on the recording medium, for creating a presentation grammar for the structured document comprises:

means, recorded on the recording medium, for identifying the content type of the original document;

means, recorded on the recording medium, for selecting, in dependence upon the content type, a full presentation grammar from among a multiplicity of full presentation grammars; and

means, recorded on the recording medium, for filtering the full presentation grammar into a presentation grammar for the structured document in dependence upon the structural elements of the structured document.

21. (Original) The computer program product of claim 20 wherein means, recorded on the recording medium, for identifying the content type comprises means, recorded on the recording medium, for identifying the content type in dependence upon a filename extension.

22. (Original) The computer program product of claim 20 wherein means, recorded on the recording medium, for identifying the content type comprises means, recorded on the recording medium, for identifying the content type in dependence upon document header elements.

23. (Original) The computer program product of claim 20 wherein means, recorded on the recording medium, for filtering the full presentation grammar comprises means, recorded on the recording medium, for writing from the full presentation grammar to the presentation grammar for the structured document each grammar element having a structural element identifier of a structural element that occurs in the structured document.

24. (Original) The computer program product of claim 20 wherein the full grammar comprises a multiplicity of grammar elements for the content type, wherein each grammar element includes:

an identifier of a structural element;

a key phrase for invoking a presentation action; and

a presentation action identifier representing a presentation action.

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM KRESS BODIN, MICHAEL JOHN BURKHART, DANIEL G. EISENHAUER, DANIEL MARK SCHUMACHER, and THOMAS J. WATSON

Appeal 2009-004171
Application 10/734,764
Technology Center 2100

Decided: January 28, 2010

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and JAMES R. HUGHES, *Administrative Patent Judges.*

THOMAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1-24. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Invention

Appellants' invention comprises:

> Creating a presentation document that include creating, in dependence upon an original document, a structured document comprising one or more structural elements and creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document.

(Spec. 56, Abstract; Figs. 3 and 4).

Representative Claim

1. A method for creating a presentation document, the method comprising:

creating, in dependence upon an original document, a structured document comprising one or more structural elements; and

creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document.

Prior Art and Examiner's Rejections

The Examiner relies on the following references as evidence of anticipation and unpatentability:

Raman	US 5,748,186	May 05, 1998
Josephson	US 2003/0023435 A1	Jan. 30, 2003

Claims 1-7, 9-15, and 17-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Raman. This reference and Josephson are utilized by the Examiner to reject claims 8, 16, and 24 under 35 U.S.C. § 103(a).

Claim Grouping

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of independent claim 1 as representative of the subject matter of independent claims 1, 9, and 17. Within the rejection under 35 U.S.C. § 102(b), no dependent claims are argued. Additionally, the rejections of various claims under 35 U.S.C. § 103(a) will be treated separately.

ISSUE

Have Appellants shown that the Examiner erred in finding that Raman teaches creating "a presentation grammar" as set forth in representative independent claim 1 on appeal?

FINDINGS OF FACT ("FF")

1. In responding to Appellants' arguments in the Brief, the Examiner sets forth at pages 12-14 of the Answer this response:

Independent claim 1 describes:

> *A method for creating a presentation document, the method comprising:*
>
> *creating, in dependence upon an original document, a structured document comprising one or more structural elements; and creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which*

includes a structural element identifier for at least one structural element of the structured document.

The claim deals with the creation of a presentation document. Raman teaches a multimodal presentation system (title). He creates a presentation document as can be seen in fig 3. The claim further describes that a structured document which already contains structural elements (thus that is the reason why it is a structured document) is created from an original document. See, Raman, col. 2, lines 18-35, col. 3, lines 6-1 1 & abstract, teaching retrieving a document and converting the information to a "common intermediate representation" with a structure of the information. Thus he converts an original document to a structured format.

Then the claims describe creation of a presentation grammar associated with the structured document. This presentation grammar includes grammar elements with identifiers. Raman already discusses the use of presentation grammar by teaching that control signals can include recognized speech (Raman, col. 6, lines 29-31). He then further states in column 3, lines 30-35 "..a voice input unit coupled to a speech recognizer, and a speech synthesizer." Thus Raman shows that the speech is tied to structured grammar components by using a speech synthesizer. Skilled artisan would realize that a speech synthesizer is for the purpose of conversion between text and speech. Thus by converting speech to textual elements, Raman creates a presentation grammar. Such a presentation grammar is created by converting the speech to textual elements in the structured document as discussed in column 5, lines 48-67 and shown in figures 2-4. Furthermore it can be seen that every component in a structured document is already identified (see fig 3). For Example the synthesizer converts the speech into a textual format it is described in a structured document with associated identifiers shown in fig 3 using tags such as <title>, <address> etc.. Raman invention deals with presentation systems and he ties in presentation grammar by converting speech to text using a synthesizer, he further uses this text for his presentation system which is already in structured format thus including identifiers.

(Ans. 12-14).

2. Raman's abstract teaches:

> In a computer system, a method is implemented for interactively presenting electronically encoded multi-media information. The information including marks to indicate a structure of the information. The method includes the steps of receiving the information, and converting the information to a common intermediate representation stored in a memory of a computer system in the form of a hierarchical attribute tree. The tree has a plurality of document objects, the document objects represent the information, the structure of the information, and procedures which can operate on the information. The common intermediate representation is presented using a plurality of user communication modalities according to the hierarchical attribute tree. While presenting the information, the method receives control signals from a user using the plurality of user communication modalities to enable the user to interactively and independently control the receiving of the information and the presentation of the information in a plurality of presentation modalities.

3. Raman teaches at column 1, lines 25-38, that hyper-text and HTML are known:

> A standard encoding scheme for multi-media information uses what is known as "hyper-text markup language." Information encoded according to this standard is easily recognized by the file postfix designation ".html,". This designation is familiar to users of WWW retrieval and presentation systems such as Netscape, and Mosaic.
>
> Hyper-text includes "marks" which define the structure of the information in the source document. For example, the text may include structural marks which indicate headers, titles, sections, paragraphs, "bullets," and so forth. The marks are used to visually format the information while it is being presented. For example, section headers may be bolded and paragraphs can be separated by line breaks and indentations.

4. In making reference to the block diagram structures of Figure 1, Raman teaches at column 4, lines 45-51 the following:

> The recognizer 130 parses the character stream into fundamental source elements, for example, title, sections, sub-sections, paragraphs, sentences, links, and forms, and so forth. The elements are stored in the intermediate high-level data structure 200. Variations in writing styles, and ambiguities in the use of the markup language make the extraction of the high level structure 200 difficult.

This data structure is illustrated in Raman's Figures 2 and 3.

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

ANALYSIS

As noted by the Examiner at page 12 of the Answer, the Appeal Brief essentially argues that Raman doesn't teach the concept of "a presentation

grammar." No other feature of representative claim 1 is argued. The Examiner's extensive remarks in the FF 1 further embellishes upon the Examiner's views as to the corresponding teachings not only of the creation of the structured document feature of the representative independent claim 1 on appeal, but upon the recited creating "a presentation grammar" feature of that claim as well. We agree.

With respect to the Examiner's reliance upon the speech recognizer and speech synthesizer teachings in Raman, Appellants make mention at pages 8 and 11 of the Brief that well-known dictation systems include such technology, but in Appellants' view, do not include capabilities for discerning grammar. On the contrary, it is the dictator or the user of these systems that instructs the dictation systems where to place paragraphs, titles, periods, and the like, all of which constitute a broadly defined "a presentation grammar" to the extent recited in the claims.

Independent of these views, Raman's abstract in FF 2 clearly indicates that Raman's teachings relate to the encoding of multi-media information such as to include marks to indicate a structure of the information and that an object-oriented approach includes document objects representing the information as well as the structure of the information itself. Moreover, the abstract further reveals that various modalities, which may be broadly construed as grammar-like, additionally teach the capability of the broadly defined "a presentation grammar" of representative independent claim 1 on appeal.

Additionally, we make reference to FF 3 and 4. These findings clearly indicate that the well-known HTML encoding techniques include encoding for not only content of an original document, but also structural elements.

The structural elements indicate the manner in which this information will be presented including headers, titles, sections, paragraphs, bullets, and so forth. These are illustrated in a tree-structured approach in Figure 2 of Raman, and are additionally relied on by the Examiner in the marked-up hypertext document of the original document in Figure 3.

Thus, a person of ordinary skill in the art would understand Raman to teach different and multiple aspects that relate to the broadly defined "a presentation grammar" as required by independent claim 1 on appeal, including grammar elements and structural element identifiers.

Pages 8-11 of the Brief take the position that Raman does not provide enabling disclosure sufficient to place a person of ordinary skill in the art in possession of each element of the claimed subject matter. Again, the focus of the arguments is that there is no enabling disclosure of presentation grammar in Raman. On the contrary, presentation grammar is clearly disclosed to a person of ordinary skill in the art as demonstrated by the Examiner's responsive arguments in FF 1, as well as our extensive reliance upon FF 2-4 as explained earlier in this opinion. Raman relies upon well-known HTML formatting techniques for documents within this patent's filing date of October 2, 1995. Additionally, Appellants present no independent evidence that Raman is not enabled, merely attorney arguments to that effect. One of ordinary skill in the art would understand FF 1-4 to present well-known techniques for structuring documents in a grammar-like manner to the extent broadly recited in representative independent claim 1 on appeal.

These remarks are consistent with our reviewing court's most recent decision, *In re Gleave*, 560 F.3d 1331 (Fed. Cir. 2009). This decision points

out that for method claims, such as representative independent claim 1 on appeal, the make requirement becomes in effect a use requirement. Appellants have not shown by suitable evidence and arguments that Raman would not enable an artisan to use or otherwise practice or carryout what Raman indicates to the reader was well known in the art.

Turning next to the rejection of claims 8, 16, and 24 under 35 U.S.C. § 103(a), pages 12 and 13 of the brief do not argue that the references to Raman and Josephson are not properly combinable within 35 U.S.C. § 103(a). Therefore, no governing case law is cited in this opinion to that effect.

We do not agree with Appellants' urging, at page 13 of the Brief, that the Examiner has not set forth the necessary factual inquiries to establish a prima facie case of obviousness. The Examiner's reasoning at pages 9-11 of the Answer, which sets forth the statement of the rejection of the noted claims, in our view, maps the corresponding requirements of representative dependent claim 8 on appeal to the relevant teachings in Raman, and identifies what Raman does not explicitly teach but that which Josephson expressly teaches. The remarks at page 13 of the Brief do not contest any of these teachings in Josephson and Raman. Instead, Appellants merely allege the Examiner's failure to set forth the necessary factual findings underpinning the rejection.

CONCLUSIONS AND DECISION

Appellants have not shown that the Examiner erred in finding that Raman teaches the broadly recited "a presentation grammar" as recited in representative independent claim 1 on appeal. Additionally, Appellants have not shown that the Examiner erred in the substance and the manner of

presenting evidence of unpatentability as to dependent claims 8, 16, and 24 on appeal. Therefore, we affirm the Examiner's rejections of various claims on appeal under 35 U.S.C. §§ 102 and 103. All claims on appeal are unpatentable.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

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